

Applicant: Bicek et al.
Application Serial No.: 09/974,653
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REMARKS

Reconsideration of the application as amended is respectfully requested.

For the record, in the Advisory Action mailed on October 4, 2004, it is indicated that the period for reply expired three months from the final rejection (dated June 15, 2004), which would have fallen on September 15, 2004. Applicants note that a response to the final Office Action was filed on August 13, 2004, within two months of issuance of the final Office Action. Accordingly, the period for reply should have correctly expired on October 4, 2004, the mailing date of the Advisory Action. Along with this Preliminary Amendment, Applicants submit a Request for Continued Examination (RCE) and a petition for a one-month extension of time, which properly gives Applicants until November 4, 2004 to file this response.

Claims 17-24 and 39 are in the application. Claims 1-16 and 25-28 have been withdrawn in view of a previous election. Claims 17 and 39 have been amended.

In the Advisory Action, the Examiner maintained, from the previous Office Action, the rejection of claims 17-24 and 39 under 35 U.S.C. §102(e) as being anticipated by Davila et al. (U.S. Patent No. 6,296,661). In response to Applicants' previous arguments relating to Davila et al., the Examiner stated in the Advisory Action,

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In the response to the Final Office Action (06/11/2004), the applicant argues that there is no disclosure or suggestion in Davila et al. to solely rely on any pressing force generated by the inner and outer stents to hold the graft in place. The examiner, respectfully, disagrees. Note that the support stent (60, best view in figs. 6 and 9e) is capable of producing a force with the main stent (80) to solely or entirely holding [sic] the sheath (104) in place. The statement of intended use and other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Davila et al which is capable of being used as claimed if one desires to do so. Since there is no structural limitation in the independent claim to clearly distinguish the present invention over the Davila reference, independent claim 17 is unpatentable over the Davila reference.

The only present rejection is an anticipatory rejection over Davila et al. As set forth in MPEP §2131, an anticipation requires a reference to teach every element of the claim. The Examiner has admitted that Davila et al. fails to affirmatively disclose that a holding force is generated between the outer stent 60 and the inner stent 80 to solely hold the graft member 70 in place. Rather, the Examiner indicated that the outer stent 60 is “capable of producing a force” with the inner stent 80. There is, however, no disclosure of the two stents actually acting to solely hold the sheath in place, as set forth in claim 17.

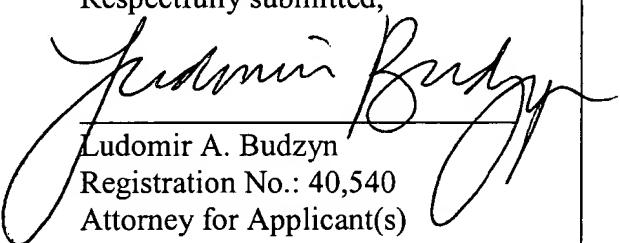
Moreover, claim 17 has been amended to adopt a portion of previous claim 39, with claim 17 presently stating “said sheath not being bonded to said at least one support stent”. This

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is clearly a structural limitation. In Davila et al., the graft member 70 has front and back ends 72 and 74, respectively, cuffed and bonded to the outer stent 60. (col. 5, lines 5-10). There is no disclosure in Davila et al. to avoid this bonding, and, accordingly, there can be no anticipation of claim 17 by Davila et al. Furthermore, Davila et al. calls for bonding the graft to a stent which is not readily performable at a point-of-use. For example, as pointed out at column 9, lines 6-8, the graft 70 is bonded to the stent under heat and pressure. There is no suggestion in Davila et al. to avoid bonding the graft to the outer stent. The subject invention of claim 17 contemplates allowing a practitioner to simply apply a sheath and mechanically fix it without bonding at a point-of-use. It is respectfully submitted that claim 17, along with dependent claims 18-24 and 39, are patentable over Davila et al.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact applicants' attorney at the number listed below.

Respectfully submitted,


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